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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,994	12/21/2004	Michael Zaiser	LO29-020	7033

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WELLS ST. JOHN P.S.  
601 W. FIRST AVENUE, SUITE 1300  
SPOKANE, WA 99201

EXAMINER
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RACHUBA, MAURINA T

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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10/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/518,994

Applicant(s)

ZAISER, MICHAEL

Examiner

Maurina Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of group IV, a subcombination in the reply filed on 16 January 2007 is acknowledged. Applicant has canceled the claims drawn to the non-elected inventions. Therefore, the restriction requirement is withdrawn.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." The German language references are listed on page 2 of the specification. Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21, 22, and 24-28 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sorrells, 4,358,913, as set forth in the previous Office action. Regarding new claims 26-28, '913 discloses an adapter part for aligning spectacle lenses, the adapter part comprising: an alignment reference structure **310** extending

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from a surface of the adapter part, the alignment reference structure configured to position a first holder relative the adapter part; and markings **287** configured to align said spectacle lenses relative other structures; the alignment reference structure comprises a transverse web, formed by the walls of **310**; the transverse web is arranged in a cavity in a side of the adapter part. Note that applicant has not claimed a direction in which the structure extends. It is the examiner's position that the opening **310** extends from the surface **306** to the interior **296**.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Mandler, 5,951,376 in view of Sorrells, 4,358,913, as set forth in the previous Office action.

### ***Response to Arguments***

6. Applicant's arguments filed 13 August 2007 have been fully considered but they are not persuasive.

7. Applicant argues that Sorrells does not disclose a "collet chuck", as that such a chuck is known in the art to have a cone-shaped collar or sleeve. The examiner does not agree with applicant's definition. The examiner agrees that the chuck must have a collar or sleeve, the collar or sleeve is movable to cause at least one structure to

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translate toward and away from a center point, to hold or release a structure. For example, such chucks are commonly used in hand-held drills, to hold the drill bit for rotation. It is the examiner's position that Sorrells does disclose a chuck **278** having structure **290, 292** that is movable toward and away from a center point to position the lens adapter **30** in proper alignment. That applicant may have other structure is moot: although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant further argues that one of ordinary skill in the art would not use the teachings of Sorrell to modify Mandler as set forth in the previous Office action, for the reasons given by the examiner. Applicant argues that one of ordinary skill in the art would not look to the teachings of Sorrells, directed to the precision processing of the end lens product, to modify Mandler, directed to grinding an intermediate lens product, or the lens blank generation. The examiner disagrees. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentive or other market forces if the variations would have been predictable to one of ordinary skill in the art. Here, the scope and content of the prior art includes similar devices, that of lens blocks, chucks and adapters. There is a design incentive, that of making the known device of Mandler as accurate and efficient as mechanically possible, to ensure desired quality and quantity, and to lower the costs of production. The differences between the claimed invention and the prior art were encompassed in the known variations disclosed by both Mandler and Sorrells. One of

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ordinary skill, in view of the design incentives, would have implemented the claimed variation of Sorrells, as the claimed variation, that of providing an adapter and chuck to allow quick mounting and dismounting of the lens block in the holder, for quicker processing times, would have been predictable. That Sorrells teaches using the claimed adapter and chuck during a different process does not negate the teachings of the claimed adapter and chuck. Applicant did not elect a method of use of such structures.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/  
Primary Examiner  
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